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09/973,004	10/10/2001	William Dale Ritchie	P67205US0	4782

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JACOBSON HOLMAN PLLC  
400 SEVENTH STREET N.W.  
SUITE 600  
WASHINGTON, DC 20004

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,004

Applicant(s)

RITCHIE ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Election/Restriction***

1. Applicant's election without traverse of Group I, Claims 1-7 in Paper No. 3 is acknowledged
2. This application contains claims 8-13 drawn to an invention non-elected without traverse in Paper No. 3. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites the limitation "said sheet" in line 8. There is insufficient antecedent basis for this limitation in the claim. What "sheet" is applicant speaking of? Is it the "carrier sheet" or the "paper sheet".

4. Claim 1 recites the limitation "the contour" in line 8. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 2 recites the limitation "said uncut region" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5 and 6, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley (6,153,279) in view of Crum et al (2003/0049403).

Charley discloses in Fig. 1, a carrier sheet (S) comprising a printed paper sheet (14) having printed matter (Col. 2, lines 40-46) containing card information; a polyfilm patch (18) adhered over the card information; a thin flexible patch of magnet material (12) adhesively secured (acrylic adhesive) secured on a rear surface of the paper sheet; a shaped die cut in the sheet (Col. 4, lines 6-10) extending through the polyfilm patch, paper sheet, and magnet material; and wherein the magnet card can be used for promotional purposes (Col. 1, lines 10-15).

However, Charley does not disclose a burstable holding means along the die cut to hold the die cut in the sheet; wherein holding tabs are formed along the die cut and have sufficient retention strength to prevent die-cut card from detaching.

Crum et al discloses a carrier sheet having a card (80) with having a die cut line (78) with burstable holding tabs (84) formed along the die cut to prevent the card from detaching.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Charley's carrier sheet with a die cut line having holding tabs as taught by Crum et al for the purpose of preventing the card from detaching inadvertently.

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7. Claims 1 and 4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (5,833,274) in view of Charley and further in view of Crum et al.

Schmidt discloses a carrier sheet comprising a label card (4) defined by cut lines (6), and which further comprises preprinted art placed on the label portion by flexographic printing; and further wherein the carrier sheet and label card is imprinted again with indicia using a laser printer.

However, Schmidt does not disclose wherein the card portion of the carrier sheet comprises: a printed paper sheet having printed matter containing card information; a polyfilm patch adhered over the card information; a thin flexible patch of magnet material adhesively secured on a rear surface of the paper sheet; a shaped die cut in the sheet extending through the polyfilm patch, paper sheet, and into the magnet material; and a holding tab means to hold the card in the sheet.

Charley discloses in Fig. 1, a carrier sheet (S) comprising a printed paper sheet (14) having printed matter (Col. 2, lines 40-46) containing card information; a polyfilm patch (18) adhered over the card information; a thin flexible patch of magnet material (12) adhesively secured (acrylic adhesive) secured on a rear surface of the paper sheet; a shaped die cut in the sheet (Col. 4, lines 6-10) extending through the polyfilm patch, paper sheet, and magnet material; and wherein the magnet card can be used for promotional purposes (Col. 1, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schmidt carrier sheet with a card portion comprising a die cut card consisting of a paper sheet layer having an adhesively secured laminate layer and magnetic

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material layer as taught by Charley for the purpose of providing a label which can be re-usable as a removable decal.

However, Schmidt as modified by Charley does not disclose wherein the label card portion comprises a holding tab means to hold the card in the sheet.

Crum et al discloses a carrier sheet having a card (80) with having a die cut line (78) with holding tabs (84) formed along the die cut to prevent the card from detaching.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schmidt's and Charley's carrier sheet with a die cut line having holding tabs as taught by Crum et al for the purpose of preventing the card from detaching inadvertently.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley in view of Crum et al, and further in view of Peterson (6,019,280).

Charley as modified by Crum et al discloses a carrier sheet comprising all the elements as claimed in Claim 1, and as set forth above. However, Charley does not disclose a paper sheet that is machine foldable in panels to constitute a glue fold envelope mailer containing an outer address panel, and an inner printed message form containing the die-cut card in a panel.

Peterson discloses in Fig. 2-4, a paper sheet (10) having foldable panels to constitute a glue fold envelope mailer containing an outer address panel (19, shown in Fig. 5, and an inner printed message (36) containing the die-cut card (30).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Charley's and Crum et al's carrier sheet to include the die-cut card in an envelope mailer as taught by Peterson for the purpose of providing a mailer with a die-cut card to be used as a return postcard.

#### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Ogikubo, Stern, Choi, Pettigrew et al, Boudouris et al, Boudouris et al ('465), Fosbenner et al, Burrows, Lowder, Niec, Owens, Brennan, and Tronrud disclose a carrier sheet having a magnetic card portion. Ritchie et al, Cox et al, Egan, Steidinger, Maxted, McIntire et al, Lomeli et al, Carlson, Mercer et al, Garrison, Chess et al, Fischer, Casagrande, and Casagrande ('051) disclose integrated detachable cards.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 14, 2003



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700